

## REMARKS

### I. Claim Rejections - 35 USC § 103

#### Requirements for *Prima Facie* Obviousness

The obligation of the examiner to go forward and produce reasoning and evidence in support of obviousness is clearly defined at M.P.E.P. §2142:

"The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness."

The U.S. Supreme Court ruling of April 30, 2007 (*KSR Int'l v. Teleflex Inc.*) states:

"The TSM test captures a helpful insight: A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art. Although common sense directs caution as to a patent application claiming as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does."

"To facilitate review, this analysis should be made explicit."

The U.S. Supreme Court ruling states that it is important to identify a *reason* that would have prompted a person to combine the elements and to make that analysis *explicit*. MPEP §2143 sets out the further basic criteria to establish a *prima facie* case of obviousness:

1. a reasonable expectation of success; and
2. the teaching or suggestion of all the claim limitations by the prior art reference (or references when combined).

It follows that in the absence of such a *prima facie* showing of obviousness by the Examiner (assuming there are no objections or other grounds for rejection) and of a *prima facie* showing by the Examiner of a *reason* to combine the references, an applicant is entitled to grant of a patent. Thus, in order to support an obviousness rejection, the Examiner is obliged to produce evidence compelling a conclusion that the basic criterion has been met.

***Komar in view of Kitsukawa***

The Examiner rejected Claims 1-10 and 12-20 under 35 U.S.C. §103(a) as being unpatentable over Komar et al (U.S. Patent Publication No. 2003/0079224 A1), hereinafter referred to as "Komar", in view of Kitsukawa et al. (U.S. Patent No. 6,282,713 B1), hereinafter referred to as "Kitsukawa".

Regarding claims 1 and 10, the Examiner argued that Komar discloses a method and system comprising: maintaining a searchable digital image database wherein said digital image database contains at least one data item (citing Komar page 3, paragraph [0024]) (The Examiner argued that here a database is disclosed in which a 3d digital image can be retrieved. The Examiner argued that this discloses the capability to store images and search for an image since databases includes operations like searching. The Examiner argued therefore it would have been obvious and is of the ordinary capability of one skilled in the art to provide a searchable database for digital images.); associating at least one object with a data item of said at least one data item, wherein said at least one object contains information relevant to said data item and wherein said at least one object comprises an iconette (citing Komar page 2, paragraphs [0020]-[0021] and page 4, paragraph [0031]); and further wherein said information relevant to said at least one data item comprises detailed information about said at least one digital image only (citing Komar page 2, paragraph [0019]; and page 4, paragraph [0023]) (The Examiner argued that here in addition to being able to provide information about

the product within the image it also can provide display area format data which deals with the actual image itself such as the bitmap information. The Examiner further argued that disclosed in Komar is the functionality to display both sources of information and one or the other as deemed for the selected area.); and displaying said data item in allocation of a display screen proximate to said at least one object, and wherein a selection of said at least one object invokes a display of said information relevant to said data item, wherein said data item is displayed simultaneously with said display of said information relevant to said data item (citing Komar page 2, paragraph [0016] and page 3, paragraph [0025]).

However, the Examiner admitted that Komar does not explicitly disclose a compacted view and that said compacted view of said data item is a compacted representation of said data item. However the Examiner argued that Kitsukawa discloses a method for providing on demand electronic advertising and further discloses a compacted view of an image (citing Kitsukawa FIG. 5 and col. 8, lines 57-67). Therefore, the Examiner argued that it would have been obvious to one having ordinary skill in the art at the time of the invention to include a compacted view of the image in Komar as taught by Kitsukawa. The Examiner argued that one would have been motivated to have the compacted view to show detailed images of possible selections such as unobstructed view with focus set on item only.

The Applicant respectfully disagrees with this assessment and notes that claim 1 and 10 have been amended to include the further limitation wherein the searchable database is a *user* searchable database. This is disclosed in the Applicant's specification in paragraph [0041] and in FIG. 5. This limitation is not disclosed in the cited prior art, as admitted by the Examiner in the "Response to Arguments" section of the current office action.

Furthermore, the Examiner has cited Komar paragraphs [0019] and [0023] for disclosing the limitation of wherein said information relevant to said at least one data item comprises detailed information about said at least one digital image only. These paragraphs from Komar are shown as follows:

[0019] Display area format data 117 includes format data for one or more selectable display areas 141-142, such as icon bitmap information, one or more actions associated with selectable display areas 141-142, and the like. Note two selectable display areas, selectable display areas 141-142, are described herein for ease of illustration. However, the number of selectable display areas that can be utilized according to various embodiments of the present invention is not limited to two selectable display areas. For example, video content 115 can contain only one selectable display area or more than two selectable display areas. It will also be appreciated that no selectable display areas may be present in some scenes of video content 115. Any reference herein made to selectable display areas 141-142 also applies to a single selectable display area and/or a plurality of selectable display areas greater than two, unless otherwise noted. (emphasis added)

[0023] Display module 110, in at least one embodiment, receives viewer input 135 and performs an action associated with the selected selectable display area of the plurality of selectable display areas 141-142. Actions to be performed can include obtaining and/or displaying information associated with a selected selectable display area, loading a form, such an ordering form, playing a video or audio clip, and the like. For example, if a viewer were to select a pair of sunglasses (one embodiment of a selectable display area) from a scene on display device 120, an action associated with the pair of sunglasses can include the display of the content of the website of the manufacturer of the pair of sunglasses. The information used to perform an action associated with selectable display areas 141-142, in one embodiment, is embedded within video stream 105 as display area action data 121-122, respectively. In this case, display module 110 could store display area action data 121-122 in a buffer or on a storage device until needed. In at least one embodiment, the type of action to be performed, as well as some or all of the information needed to perform the action, is provided as display area format data 117. For example, an action associated with selectable display area 141 can include retrieving and displaying an order form for the product represented by selectable display area 141. In this case, display area format data 117 could include a value representing the action of retrieving order form data from external data source 130, a value representing the location of the order form data in a buffer, and a value representing the action of displaying the order form. A separate display area format data 117 can include information for each of a plurality of selectable display areas 141-142, or display area format data 117 can include format and action data for some or all of selectable display areas 141-142. For example, display area format data 117 can include a selectable display area identification (ID) associated with each of selectable display areas 141-142, their corresponding one or more actions, and information needed for these actions, such as a uniform resource locator (URL) address, a file name, and the like. (emphasis added)

The limitation of the Applicant's claims is that the relevant information displayed is detailed information of the digital image *only*. First of all, Komar does not, in fact, disclose relevant information displayed which comprises detailed information about *the digital image*. This is shown in the Examiner's citation above as Komar discloses *display area format data* 117 which is not disclosed as being displayed to the user. This is format data so that the Komar system is enabled to display information about *the product*. Without format data pertaining to the display area, the system of Komar obviously would be unable to display anything in the display area. Regardless of the use of the "display area format data" it is not information about the digital image nor is it displayed to the user. In other words, the Examiner has not shown how this can be detailed information about the *digital image*. Additionally, the claim limitation includes the term "only" in that the only information is detailed information about the image. Komar discloses information which is information a product (not an image) and therefore, does not disclose "only" information about an image.

The Examiner has argued that the ability to display information, rather it be about a product or an image, is well known in the art because the data is a string of ones and zeros and therefore can be manipulated by the user. The Applicant is confused by this rationale. The information displayed *about* the image is copyright information, file size, file format etc and of course being on a computer system, is also ones and zeros. How does the fact that the image and the detailed information are ones and zeros and can be manipulated on a computer system make the ability to display detailed information about the image well known and obvious? There does not seem to be a nexus between the image of ones and zeros and the Examiner's argument that it is well known in the art. Furthermore, the Examiner has not provided any evidence to support this argument. Is the Examiner arguing that since the image is ones and zeros in a computer that *anything* in a computer is therefore able to be manipulated and therefore obvious?

The Examiner has combined the Komar and Kitsukawa references, arguing that the motivation to combine the references is "to have the compacted view to show detailed images of possible selections such as unobstructed view with focus set on item only". The Examiner has not cited any location within either Komar or Kitsukawa where this *unobstructed view with the focus set on the item* is displayed. The Examiner is making a motivation argument based on details in the cited references which are not disclosed. Therefore, the Applicant again submits that a compacted view inherently cannot show *more* detail than a full-sized image even with an unobstructed view with the focus set on the item only. As a compacted view of an image *cannot* show greater detail than a full-sized image, the Applicant submits there would be no motivation by one of ordinary skill in the art to combine the Komar and Kitsukawa references as cited by the Examiner.

Therefore, Komar in view of Kitsukawa does not disclose 1) displaying relevant information about *the data item* wherein the data item comprises a digital image; 2) wherein said information relevant to said at least one data item comprises *detailed information* about said at least one digital image only; or 3) a *user* searchable database.

Komar in view of Kitsukawa therefore fails in the aforementioned *prima facie* obviousness test as each and every limitation of the Applicant's invention is not disclosed. Additionally, the Applicant submits that there would not be a motivation by one of ordinary skill in the art to combine the Komar and Kitsukawa references. Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C. §103(a) rejections of claims 1 and 10 based on the Komar and Kitsukawa references be withdrawn.

Regarding claims 2 and 12, the Examiner argued that Komar and Kitsukawa disclose a method and system as in claims 1 and 10 above and further discloses automatically invoking display of information relevant to said data item in response to dragging a graphically displayed cursor across said at least one object displayed

on said display screen (citing Komar, page 2, paragraph [0021] and page 4, paragraphs [0031] and [0032]).

Regarding claim 3, the Examiner argued that Komar and Kitsukawa disclose a method and system as in claim 1 above and further discloses selecting said at least one object to invoke a display of information relevant to said data item (citing Komar, page 2, paragraph [0016]).

Regarding claims 4 and 14, the Examiner argued that Komar and Kitsukawa disclose a method and system as in claims 1 and 10 above and further discloses information relevant to said data item in a form of graphical pop-up window, which when selected by user activates an additional graphical window comprising further information relevant to said data item (citing Komar, page 3, paragraph [0025] and page 4, paragraphs [0031] and [0032]).

Regarding claims 5 and 15, the Examiner argued that Komar and Kitsukawa disclose a method and system as in claims 1 and 10 above and further discloses information relevant to said data item in a form of graphical pop-up window, which when selected by user activates an additional graphical window comprising further information relevant to said data item as in claims 4 and 14 above and further discloses that the additional graphical window comprises an interactive region for initiating at least one user transaction thereof (citing Komar, page 2, paragraph [0016]).

Regarding claim 6 and 16, the Examiner argued that Komar and Kitsukawa disclose a method and system as in claims 1 and 10 above and further discloses at least one object as a graphical iconette displayable on said display screen (citing Komar, page 2, paragraph [0016]; page 4, paragraph [0004] and page 31).

Regarding claims 7 and 17, the Examiner argued that Komar and Kitsukawa disclose a method and system as in claims 1 and 10 above and further discloses that the item comprises a graphical image (Komar, page 2, paragraph [0017]; page 3, paragraph [0026]).

Regarding claims 8 and 18, the Examiner argued that Komar and Kitsukawa disclose a method and system as in claims 1 and 10 above and further discloses displaying a compacted view of a plurality of data items in a display area of a display screen, wherein at least one data item among said plurality of data items is displayed proximate to at least one object containing information relevant to said at least one data item, wherein a selection of said at least one object invokes a display of information relevant to said at least one data item (citing Komar, page 2, paragraph [0016]; page 23, paragraph [0023]; and page 4, paragraph [0031]).

Regarding claim 9, the Examiner argued that Komar and Kitsukawa disclose a method as in claim 1 above and further discloses: a) displaying data associated with said data item as a graphical icon on said display screen (citing Komar, page 2, paragraphs [0016] and [0020]); and b) displaying said at least one object as a graphical iconette embedded within a graphical frame surrounding said graphical icon, wherein said graphical iconette can be invoked by said user to display information relevant to said graphical icon (citing Komar, page 4, paragraph [0031]).

The Applicant respectfully disagrees with this assessment and notes that the arguments presented above against the rejections of claims 1 and 10 applies equally against the rejections of claims 2-9, 12 and 14-18 as these claims are dependent upon either claim 1 or 10. As submitted above, Komar in view of Kitsukawa fails in the aforementioned *prima facie* obviousness test as each and every limitation of the Applicant's independent claims is not disclosed. Additionally, as submitted above, there would be not be a motivation to combine the Komar and Kitsukawa references as cited by the Examiner.

Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C. §103(a) rejections of claims 2-9, 12 and 14-18 based on the Komar and Kitsukawa references be withdrawn.

***Komar in view of Kitsukawa and Willner***



**Patent Application Serial No. 10/756,988**

The Examiner rejected claim 13 under 35 U.S.C. §103(a) as being unpatentable over Komar and Kitsukawa as applied in claim 10, and further in view of Willner et al. (U.S. Patent No. 7,149,370), hereinafter referred to as "Willner".

Regarding claim 13, the Examiner argued that Komar and Kitsukawa disclose a method and system as in claim 10 above and further discloses selecting said at least one object to invoke a display of information relevant to said data item (citing Komar, page 2, paragraph [0016]). The Examiner admitted that the combination does not explicitly disclose wherein said object of information includes at least one of the following; copyrights, tile size, tile format, royalties file permissions and conditions of use.

However, the Examiner argued that Willner discloses a method and device for image surfing and discloses providing additional information about image including file size (citing Willner col. 8, lines 24-31). The Examiner argued therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to provide file information as relevant information in the modified Komar as taught by Willner. The Examiner argued that one would have been motivated to provide file information to inform user specific details which can enhance user's knowledge and inform them of the possible capabilities.

The Applicant respectfully disagrees with this assessment and notes that the arguments presented above against the rejections of claims 1 and 10 over Komar in view of Kitsukawa applies equally against the rejection of claim 13 as this claim is dependent upon claim 10. Additionally, the Applicant notes that claim 13 has been amended wherein said object of information includes copyrights and at least one of the following; file size, file format, royalties, file permissions and conditions of use. Komar in view of Kitsukawa and Willner does not disclose this limitation.

Additionally the Applicant submits that there would be no motivation to combine the Komar, Kitsukawa and Willner references as argued by the Examiner. The Applicant previously has submitted that there would not be a motivation to combine the Komar, Kitsukawa and Willner references and the Examiner has not

addressed this argument of the Applicant's. This argument is therefore restated as follows.

The Examiner stated "One would have been motivated to provide file information to inform user specific details which can enhance user's knowledge and inform them of the possible capabilities". What possible capabilities would the user have with the file size in the system of Komar and Kitsukawa? The Examiner has cited the Willner reference for the disclosure of providing additional information about images, including *file* size. However, the Examiner has not stated why a user of Komar would be motivated to provide additional information about the *file size of the image*.

Komar is an advertising system and method wherein the *product* is the item of interest, not the digital image. Why would anyone be interested in knowing the file size of the digital images of the products as disclosed by Willner in the system of Komar? Knowledge of the file size would provide no incentive to a user to purchase the product advertised in Komar, nor would it provide any information about the product itself; i.e. it would not enhance the user's knowledge and would not provide any useful information about possible capabilities of the *product* advertised in Komar. Relevant information in the Komar system and method is relevant to the *product* not the *digital image*. The Examiner has not submitted any explicit reason why a user of Komar would be motivated to provide digital image file size information to prospective customers of the product and therefore has not made a *prima facie* case of obviousness as one of ordinary skill in the art would not be motivated to modify Komar as in the Willner reference.

Therefore the Applicant submits that Komar in view of Kitsukawa and further in view of Willner fails in the aforementioned *prima facie* obviousness test as each and every limitation of the Applicant's claim is not disclosed. Additionally, the Examiner has not provided an explicit reason why one of ordinary skill in the art would be motivated to combine the references.

Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C. §103(a) rejection of claim 13 based on the Komar, Kitsukawa and Willner references be withdrawn.

***Komar in view of Kitsukawa and Gayraud***

The Examiner rejected claim 20 under 35 U.S.C. §103(a) as being unpatentable over Komar, Kitsukawa and Gayraud et al. (U.S. Patent No. 5,436,637), hereinafter referred to as "Gayraud".

Regarding claim 20, the Examiner argued that Komar discloses a system comprising: maintaining a searchable digital image database wherein said digital image database contains at least one data item (citing Komar page 3, paragraph [0024]; the Examiner argued that here a database is disclosed in which a 3d digital image can be retrieved. The Examiner argued that this discloses the capability to store images and search for an image since databases includes operation like searching. The Examiner argued that therefore it would have been obvious and is of the ordinary capability of one skilled in the art to provide a searchable database for digital images); at least one iconette associated with a data item of said at least one data item wherein said at least one iconette contains information relevant to said to data item (citing Komar page 4, paragraph [0031]; the Examiner argued that once selected, the information about the item is available therefore an icon or iconette is associated with the item) and wherein said information relevant to said at least one data item comprises detailed information about said at least one digital image only (citing page 2, paragraph [0019]; page 3, paragraph [0023]). The Examiner argued that in addition to being able to provide information about the product within the image it also can provide display area format data which deals with the actual image itself such as the bitmap information. The Examiner argued that disclosed is the functionality to display both sources of information and one or the other as deemed for the selected area.

The Examiner argued that a display module for displaying a compacted view of said data item in a location of a display screen proximate to said at least one iconette, and wherein a selection of said at least one iconette invokes a display of information relevant to said data item and wherein said data item is displayed simultaneously with said display of said information relevant to said data item (citing page 3, paragraph [0025]; page 2, paragraphs [0016] and [0020]; page 4, paragraph [0031]).

The Examiner admitted that however Komar does not explicitly disclose a compacted view and that said compacted view of said data item is a compacted representation of said data item. The Examiner argued that however Kitsukawa discloses a method for providing on demand electronic advertising and further discloses a compacted view of an image (citing FIG. 5, col. 8, lines 57-67). The Examiner stated that therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to include a compacted view of the image in Komar as taught by Kitsukawa. The Examiner argued that one would have been motivated to have the compacted view with focus set on item only.

The Examiner admitted that Komar also does not explicitly disclose wherein said display module displays data associated with said data item as a graphical icon on said display screen.

The Examiner argued that Gayraud discloses a graphical user interface system and methods for improved user feedback and further discloses hints of icons containing text or graphical messages of what an icon represents (citing col. 3, lines 45-59). The Examiner argued that therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to include hints of data about what the icon represented in Komar as taught by Gayraud. The Examiner argued that one would have been motivated to have hints about the icon to improve the user-friendly aspect of the application because it allows the user to view where the icon will guide the user.

The Applicant respectfully disagrees with this assessment and notes that the argument presented above against the rejections of claims 1 and 10 applies equally against the rejection of claim 20. The Applicant further notes that claim 20 has been amended similar to claims 1 and 10 wherein the searchable database is a *user* searchable database. As submitted above, Komar fails to disclose 1) displaying relevant information about the data item wherein the data item comprises a digital image; 2) wherein said information relevant to said at least one data item comprises detailed information about said at least one digital image only; or 3) a user searchable database.

Gayraud does not disclose the above limitations. Therefore, Komar in view of Kitsukawa and Gayraud fails in the aforementioned *prima facie* obviousness test as each and every limitation of the Applicant's claim is not disclosed. Additionally, as submitted above, one of ordinary skill in the art would not be motivated to combine the Komar and Kitsukawa references, as submitted above.

Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C. §103(a) rejection of claim 20 based on the Komar, Kitsukawa and Gayraud references be withdrawn.

***Komar in view of Kitsukawa, Gayraud and Willner***

The Examiner rejected claim 21 under 35 U.S.C. §103(a) as being unpatentable over Komar, Kitsukawa, and Gayraud as applied in claim 20 and further in view of Willner.

Regarding claim 21, the Examiner argued that Komar, Kitsukawa and Gayraud disclose a method and system as in claim 20 above and further discloses a selection module for selecting said at least one iconette to invoke said display of information relevant to said data item (citing Komar, page 2, paragraph [0016]). However, the Examiner admitted that Komar, Kitsukawa and Gayraud do not explicitly disclose wherein said object of information includes at least one of the following; copyrights, file size, file format, royalties file permissions and conditions

of use. However, the Examiner argued that Willner discloses a method and device for image surfing and discloses providing additional information about image including file size (citing Willner col. 8, lines 24-31). The Examiner argued that one would have been motivated to provide file information to inform the user of specific details which can enhance user's knowledge and inform them of the possible capabilities.

The Applicant respectfully disagrees with this assessment and notes that the argument presented above against the rejections of claims 1, 10, 13 and 20 applies equally against the rejection of dependent claim 21. Additionally, the Applicant notes that claim 21 has been amended similar to claim 13 wherein the information includes copyrights. This limitation is not disclosed in Komar in view of Kitsukawa, Gayraud and Willner.

Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C. §103 (a) rejection of claim 21 based on the Komar, Kitsukawa, Gayraud and Willner references be withdrawn.

## **II. Conclusion**

In view of the foregoing discussion, the Applicant has responded to each and every rejection of the Official Action. The Applicant has clarified the structural distinctions of the present invention. Applicant respectfully requests the withdrawal of the rejections under 35 U.S.C. §103 based on the preceding remarks. Reconsideration and allowance of Applicant's application is also respectfully solicited. A Request for Continued Examination (RCE) under 37 CFR 1.114 is also submitted herewith, including the RCE fee of \$810.

Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact the undersigned representative to conduct an interview in an effort to expedite prosecution in connection with the present application.

Respectfully submitted,



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Kermit Lopez  
Attorney for Applicants  
Registration No. 41,953  
ORTIZ & LOPEZ, PLLC  
P.O. Box 4484  
Albuquerque, NM 87196-4484  
505-314-1312